

Appl. Serial No. 10/666,399
Reply to Office Action of December 22, 2009
Response Dated March 22, 2010
Docket No. P0298US-7

REMARKS AND ARGUMENTS

Claims 1-13, 15-33 and 35-46 are pending in the application of which claims 1-12, 20-33 and 35-41 were withdrawn from consideration. Claims 13, 15-19 and 42-46 are rejected by the examiner.

CLAIM REJECTIONS

35 USC 112, first paragraph

Claims 13, 15-19, 42-46

The Office rejected claims 13, 15-19 and 42-46 under 35 USC 112, first paragraph, as failing to comply with the enablement requirement.

Regarding claim 13, the Office writes that the limitation of "injection or otherwise introducing curable coating material into said mold under ambient pressure" in lines 13-14 was not described in the specification. Claims 15-19 and 42-45 depend from claim 13 and so are rejected for the same reasons. Claim 13 is amended in the present response to delete reference to "under ambient pressure." Withdrawal of the rejection of claims 13, 15-19 and 42-45 is requested.

Regarding claim 46, the Office writes that the limitation "without a bias between said between either [sic] of said upper and lower sections and the features of said semiconductor devices" in lines 12-14 was not described in the specification. Claim 46 is amended in the present response to delete reference

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to the limitation, and so the applicant requests withdrawal of the rejection of claim 46.

Claim 46

The Office rejected claim 46 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject invention. The Office writes that no antecedent basis exists for "the features of said semiconductor devices." (Claim 46).

Claim 46 is amended in the present response to delete reference to "the features of said semiconductor devices." Withdrawal of the rejection of claim 46 is requested.

35 USC 102(b)

Claim 46

The Office rejected claim 46 under 35 USC 102(b) as being anticipated by Mitchell et al., US Patent 5,766,987 ("Mitchell").

The applicant amends claim 46 in the present response to include the limitation, "each of said semiconductor devices being separately mounted in a pattern within said formation cavity and provided with a space between respective tops of said semiconductor devices and said rigid upper section to receive a curable coating material." (Underscore indicating additions) Support for the amendment is found at least at page 19, line 31 through page 20, line 1, and Page 20, lines 15-19, of the

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applicant's disclosure. The applicant asserts that Mitchell teaches "the top fixture element 32 bears on the terminals 64 and dielectric layers 60 of the subassemblies through the top covering layer 84" (col. 8, lns. 6-9) to "prevent contamination of terminal 64" (col. 9, lns 10-12) with the encapsulant. No space is taught between the subassemblies and top fixture element 32 "to receive a curable coating material" and so the applicant requests withdrawal of the 102(b) rejection of claim 46.

35 USC 103(a)

Claims 13, 15-19, 44 and 45 were rejected under 35 USC 103(a) as being unpatentable over Mitchell, in view of Oosedo et al. (WO 2003/002661, US Publication 2004/0031952 to Oosedo et al., which is a U.S. publication equivalent to the International publication, to be used as a translation for the International application).

The applicant amends claim 13 in the present response to include the limitation, "said curable coating material comprising at least one phosphor." Support for the amendment is found at least at page 13, lines 20-27 of the applicant's disclosure. Applicant respectfully asserts that Mitchell does not teach or suggest use of a phosphor in the curable coating material and that such a new limitation does not encroach upon non-elected species II (See Office Action response June 16, 2008) as the new limitation may be used with many different semiconductor devices (e.g., laser devices). For at least the

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reasons stated herein, the applicant requests withdrawal of the 103(a) rejection of claim 13.

Claims 42 and 43 were rejected under 35 USC 103(a) as being unpatentable over Mitchell and Oosedo, as applied to claim 13, and further in view of Soules et al., US Patent 6,252,254. Claims 42 and 43 ultimately depend from claim 13 and so contain each of its limitations. For at least the reasons stated above for claim 13, the applicant requests withdrawal of the 103(a) rejection of claims 42 and 43.

CONCLUSION

Claims 13, 15-19 and 42-46 are in condition for allowance. A timely Notice of Allowance is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees required to Deposit Account 11-1580.

Respectfully submitted,

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